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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,751	12/08/2003	Steven Spencer	12013/50201	9372

23838 7590 08/16/2004

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EXAMINER	
LAMB, BRENDA A	

ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/728,751	Spencer et al
Examiner	**Group Art Unit**
LAMB	1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 1-22 is/are pending in the application.

Of the above claim(s) 14-22 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 1-7, 11 and 13 is/are rejected.

☑ Claim(s) 8-10 and 12 is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☑ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13, drawn to apparatus, classified in class 118, subclass 303.

II. Claims 14-22, drawn to method, classified in class 427, subclass 2.1.

The inventions are distinct, each from the other because:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as coating nuts, bolts and screws.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney Fred Grasso on 6/17/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-22 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 6, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Murray.

Marray teaches the design of an apparatus for treating a substrate comprised of a treatment chamber as shown in Figure 1. Murray treatment chamber has the following: an entrance capable of allowing passage of medical implant; and an inside surface and outside surface with a plurality of fluid passages (elements 46, 47, 48) which pass from the outside surface to the inside surface to create a buffer zone on zone of surplus fluid between the substrate and inside surface of chamber. Murray shows a supply line/conduit for supplying a fluid which is coupled to at least one of the fluid passages. Murray's supply line is capable of supplying a compressible fluid to at least one of the fluid passage. Thus Murray teaches every structural element of the claimed apparatus set forth in claim 1. With respect to claim 3, Murray shows the treatment chamber is cylindrical and a cross-sectional view shows apertures or openings are uniformly spaced and positioned along the inside surface of the chamber. With respect to claim 6, Murray teaches the treatment chamber comprises end caps (elements 60 and 58). With respect to claim 13, absent a clear recitation of how the compressible fluid relates to the first and second coating fluid, Murray shows a first and second supply of coating (elements 30, 32) are coupled to the treatment chamber.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Latta et al.

Latta et al teaches the design of an apparatus for treating substrates as shown in Figure 1-2 comprised of treatment chamber having the following elements: an inside

surface; an outside surface; and an entrance. Latta et al treatment chamber has a plurality of fluid passages 14, 14' passing from the outside to the inside surface and shows a line or conduit is fluidly coupled to the fluid passages. Latta et al apparatus is capable is capable of treating medical devices. Latta et al teaches every element of the apparatus as set forth in claim 1. With respect to claim 2, Lattle et al teaches an injection nozzle (elements 13, 15, 15') positioned within the treatment along the longitudinal axis of the treatment chamber Latte et al injection nozzle is capable of injecting a therapeutic. With respect to claim 4, Latta et al teaches an outer case 12 surrounding the treatment chamber, a heating element 20 in thermal communication with the inside surface of the treatment chamber and a supply of coating inherently fluidly applied to nozzle and treatment chamber in order for the fluid to be introduced through the nozzle.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over combination of Murray et al and Berg et al.

Murray et al is applied for the reason noted above. Murray et al fails to teach passages are coupled to a therapeutic. Berg et al teaches a method for treating a medical device-a stent. Berg et al teaches the coating applied to the stent includes a therapeutic material. Berg et al teaches a variety of techniques can be used to apply coating to the sent and can include immersion coating (see Berg et al at column 4 lines 19-34). Berg et al fails to disclose the coating apparatus having structure within scope of claim. However, it would have been obvious to practice the Berg et al process for

coating a medical device with a coating which include a therapeutic using the Murray et al coating device for the taught advantage of the Murray et al –uniform coating.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray et al in view of Aikawa et al.

Murray et al is applied for the reasons noted above. Murray et al fails to teach the treatment chamber is not opaque. However, it would have been obvious to manufacture the Murray et al treatment chamber from a material which is not opaque since it is known to construct a coating apparatus from transparent material such as transparent quartz such as taught by Aikawa et al for the taught advantages of transparent quartz –high corrosion resistance (see Aikawa et al –column 4 lines 13-22).

Claims 1-3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz et al.

Schwarz et al teaches the design of an apparatus for treating substrate as shown in Figure 1-2 comprised of treatment chamber having the following: an inside surface; an outside surface; and an entrance. Schwarz et al treatment chamber has a plurality of fluid passages 14, 14' passing from the outside to the inside surface and shows line or conduit is fluidly coupled to the fluid passage. Schwarz et al apparatus is capable of treating medical devices. Schwarz et al teaches every element of the apparatus as set forth in claim 1. With respect to claims 2 and 4, Schwarz et al teach an injection nozzle (element 160) positioned within the treatment along the longitudinal axis of the treatment chamber Schwarz et al injection nozzle injects coating and therapeutic material from a source of coating and source of therapeutic material which are fluidly

coupled to the fluid passages. Schwarz et al show that a compressible fluid source fluidly coupled to the fluid passages. With respect to claim 3 and 6, Schwarz et al teaches treatment chamber may be cylindrical (see column 7 lines 54-57). Schwarz et al teaches shows the fluid passageways are uniformly spaced along a lower portion of the inner surface of the chamber. Schwarz et al shows an exhaust and end cap or filter.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 is confusing due to a grammatical error. At line 3 of claim 3 after "inside surface" delete "of the inside surface".

Claims 8-10 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Brenda Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday thru Tuesday and Thursday thru Friday with alternate Wednesdays.

B. A. Lamb/af
July 21, 2004

BRENDA A. LAMB
PRIMARY EXAMINER